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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,735

11/13/2003

Indran Naick

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EXAMINER

NGUYEN, PHUOC H

ART UNIT

PAPER NUMBER

2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/713,735

**Applicant(s)**

NAICK ET AL.

**Examiner**

Phuoc H. Nguyen

**Art Unit**

2143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

The applicant is advised to update information cited under the "Cross-Reference to Related Applications" in page 1 of original specification.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17-20 cite a machine-accessible medium containing instructions for modifying an email attachment. In order for medium claims to be statutory, the claims must cite in a tangible readable medium. However, claims 17-20 disclose the accessible medium is signal-bearing in page 19 of the original specification which is considered as non-tangible medium. Therefore, claims 17-20 are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-13, 15-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Erev et al. (U.S. Publication No. 2003/0084106).

Re claim 1, Erev discloses in Figures 2-5 a method for replacing an email attachment of an email with a call (e.g. abstract and Figure 2 wherein the call is the reference to the location of the attachment which stored in the media store server), the method comprising:

removing the email attachment from the email, thereby producing a stripped email (e.g. RS2 in Figure 2 which remove the attachment from the email message generated from the attachment box);

storing the email attachment (e.g. storing the attachment as multi-media data in the media 2 in Figure 2);

adding the call to the stripped email (e.g. generate a reference as call and attach to the email prior sending to the RC 1 in Figure 2), wherein the call is configured to retrieve the email attachment upon activation by a recipient of the stripped email (e.g. paragraphs [0009] and [0019]); and

forwarding the stripped email with the call to the recipient (e.g. from RS2 to RC1 in Figure 2).

Re claim 2, Erev further discloses in Figures 2-5 receiving a request for transmission of the email attachment in response to activation of the call (e.g. paragraph [0019] wherein the request is made from the media client to the media store); and transmitting the email attachment to the recipient in response to the request (e.g. the media store send the attachment file as multi-media data corresponding to the reference to the media client).

Re claim 4, Erev further discloses in Figures 2-5 partitioning a mail server to create the attachment server (e.g. paragraph [0089] wherein the mail server and media server are located in the same machine).

Re claim 5, Erev further discloses in Figures 2-5 storing comprises storing the email attachment in storage associated with an attachment server (e.g. file is stored from SC1 to media store in Figure 2), the attachment server being configured to transmit the email attachment in response to activation of the call by the recipient (e.g. paragraph [0035]).

Re claim 6, Erev further discloses in Figures 2-5 adding the call comprises adding code to the email, the code being configured to automatically execute upon display of the email via an email client associated with the recipient, to request transmission of the email attachment (e.g. paragraphs [0032-0035] wherein the code is the reference in form of URI).

Re claim 7, Erev further discloses in Figures 2-5 adding the call comprises adding a hyperlink to the email, wherein the hyperlink is configured to initiate code associated with the email attachment to transmit the email attachment to the recipient (e.g. paragraphs [0005 and 0032-0035]).

Re claim 8, Erev further discloses in Figures 2-5 the hyperlink, upon activation, initiates access to an Internet protocol address associated with the email attachment (e.g. paragraphs [0032-0035] wherein the code is the reference in form of URI).

Re claim 9, it is a device claim of claim 1. Thus, claim 9 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 10, it is a device claim of claim 2. Thus, claim 10 is also rejected under the same rationale as cited in the rejection of rejected claim 2.

Re claim 11, it is a device claim of claim 3. Thus, claim 11 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

Re claim 12, it is a device claim of claim 4. Thus, claim 12 is also rejected under the same rationale as cited in the rejection of rejected claim 4.

Re claim 13, it is a device claim of claim 5. Thus, claim 13 is also rejected under the same rationale as cited in the rejection of rejected claim 5.

Re claim 15, it is a device claim of claim 7. Thus, claim 15 is also rejected under the same rationale as cited in the rejection of rejected claim 7.

Re claim 16, it is a device claim of claim 6. Thus, claim 16 is also rejected under the same rationale as cited in the rejection of rejected claim 6.

Re claim 17, it is a computer-accessible medium claim of claim 1. Thus, claim 17 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 18, it is a computer-accessible medium claim of claim 2. Thus, claim 18 is also rejected under the same rationale as cited in the rejection of rejected claim 2.

Re claim 20, it is a computer-accessible medium claim of claim 4. Thus, claim 20 is also rejected under the same rationale as cited in the rejection of rejected claim 5.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 14, and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Erev et al. (U.S. Publication No. 2003/0084106) in view of Hanna et al. (U.S. 7,054,905).

Re claim 3, Erev fails to disclose in Figures 2-5 authenticating the request prior to transmission of the email attachment. However, Hanna et al. disclose the step of authenticating the request prior to transmission of the email attachment (e.g. 314 in Figure 3 as authentication is required prior downloading attachment from server).

Therefore, it would have been obvious to a person having ordinary skill in the at the time the invention is made to add the step of authenticating the request prior to transmission of the email attachment as seen in Hanna et al.'s invention into Erev et al.'s invention

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because it would enable to allow only authorized user to view the attachment for security reason (e.g. col. 5 lines 7-16).

Re claim 14, it has similar limitations cited in claim 3. Thus, claim 14 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

Re claim 19, it is a computer-accessible medium claim of claim 3. Thus, claim 19 is also rejected under the same rationale as cited in the rejection of rejected claim 3.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Pub. No. 2003/0200267
- b. U.S. Patent No. 5,903,723
- c. U.S. Patent No. 7,054,905

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919.

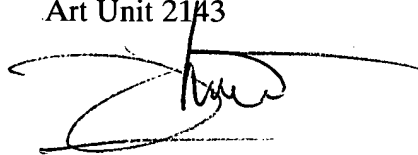
The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuoc H Nguyen  
Examiner  
Art Unit 2143

A handwritten signature in black ink, appearing to read 'Phuoc H Nguyen', is written over the printed name and title.

March 24, 2007